## REMARKS/ARGUMENTS

Entry of this response and reconsideration and allowance of the above-identified patent application are respectfully requested. Claims 1-34 were rejected in the office action. No claims have been amended or added. Therefore, following entry of the present response, claims 1-34 will remain pending in the present application.

Claims 1-5, 14-15, 22-28 and 32-34 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,251,251 to Barber *et al.* ("Barber") in view of U.S. Patent No. 5,860,064 to Henton ("Henton"). Specifically, the office action suggests that while Barber fails to disclose a voice mail system "having a distinct mood," Henton's column 3, lines 13-22 teaches having such a distinct mood. (*Office Action dated December 1, 2003* at p. 3). Moreover, the office action's rationale for combining the two references is that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the personalized messages of Barber by adding the sliding scale ***affecting voice messages as taught by Henton***." (*Office Action dated December 1, 2003* at p. 3) (emphasis added). With all due respect to the contentions in the office action, applicants respectfully disagree.

Contrary to the contention in the office action, Henton does not teach using mood to "***affect[] voice messages***." On the contrary, as its very title suggests, Henton teaches automatically generating vocal emotion in a ***text-to-speech system***, and ***not*** a voice message system. Accordingly, applicants respectfully assert that the combination of Barber and Henton is not, by itself, sufficient to establish a prima facie case of obviousness. M.P.E.P. § 2143.01.

"The prior art must provide a motivation or reason for the worker in the art, ***without the benefit of [applicant's] specification***, to make the necessary changes in the reference device." M.P.E.P. § 2144.04 (citing *Ex parte Chicago Rawhide Manufacturing Co.*, 223 U.S.P.Q. 351, 353 (Bd. Pat. App. & Inter. 1984) (emphasis added). To establish a prima facie case of obviousness, "there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant." *In re Dance*, 160 F.3d 1339, 1343 (Fed. Cir. 1998). "In other words, the examiner must show reasons that the skilled artisan, confronted with the same problem as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Here, applicants respectfully assert that the office action failed to establish a *prima facie* case of obviousness because neither Barber nor Henton provide specific guidance that would lead one of ordinary skill in the art to the present invention. Specifically, Henton teaches automatically generating vocal emotion in the wholly distinct environment of a text-to-speech system, and ***not*** a voice message system. This is significant because a text-to-speech system, like Henton's, that automatically generates a spoken mood from written text involves very different considerations than a voicemail system that allows a user to personalize a voice mail system with mood. This is evident from the fact that while the entirety of Henton's specification goes into great detail about how to automatically determine mood from written text, no where does Henton mention or even suggest a voice mail system.

Certainly, applicant acknowledges that the abstract idea of a person's voice projecting a particular mood is a well known feature of human interaction. However, Henton's text-to-voice system is less relevant to voice mail systems than this acknowledged aspect of human

nature. Therefore, neither Henton nor Barber provide the necessary motivation to combine. In fact, the only motivation to combine in the present record is the motivation provided by the applicant's specification itself, which forbidden to be attributable to the prior art under current law.

Accordingly, applicant respectfully requests withdrawal of the rejection of claims 1-5, 14-15, 22-28 and 32-34 under 35 U.S.C. §103 (a) over Barber in view of Henton.

In addition, claims 6-8 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton and in further view of U.S. Patent No. 4,850,005 to Hashimoto ("Hashimoto"). Also, claims 9-11 and 29-30 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton and in further view of U.S. Patent No. 6,005,928 to Johnson ("Johnson"), and claims 12-23 and 31 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton, Hashimoto and Johnson. Finally, claims 16-17 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton and in further view of U.S. Patent No. 4,785,473 to Pfeiffer *et al.* ("Pfeiffer"), claim 18 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Pfeiffer and U.S. Patent No. 5,905,774 to Tatchell *et al.* ("Tatchell"), claims 19-20 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton and Pfeiffer and U.S. Patent No. 5,825,871 to Mark, and claim 21 stands rejected under 35 U.S.C. §103 (a) as being unpatentable over Barber in view of Henton, Pfeiffer and U.S. Patent No. 5,930,700 to Pepper *et. al* ("Pepper").

For the same reasons discussed above with respect to the rejection of claims 1-5, 14-15, 22-28 and 32-34 under 35 U.S.C. §103 (a) over Barber in view of Henton, applicant

respectfully requests withdrawal of claims 6-13, 17-21 and 29-31, all of which are rejected as indicated above.

## CONCLUSION

In view of the foregoing, applicant respectfully submits that the claims are allowable and that the present application is in condition for allowance. Reconsideration of the application and an early Notice of Allowance are respectfully requested. In the event that the Examiner cannot allow the present application for any reason, the Examiner is encouraged to contact the undersigned attorney, Vincent J. Roccia at (215) 564-8946, to discuss resolution of any remaining issues.

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